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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/928,585	08/13/2001	Maria G. Rojas	0107.00	7883

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USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER
NATIONAL CTR FOR AGRICULTURAL UTILIZATION RESEARCH
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PEORIA, IL 61604

EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 05/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/928,585

Applicant(s)
Rojas et al.

Examiner
John Pak

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1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 21, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.
- ### Disposition of Claims
- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☒ Claim(s) 25-27 is/are allowed.
- 6) ☒ Claim(s) 1-16, 20, 21, 23, and 24 is/are rejected.
- 7) ☒ Claim(s) 17-19 and 22 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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Claims 1-27 are pending in this application.

Applicant's election with traverse of gossypol as the single disclosed species of phytophage toxin and fungi insecticidal agent as the single disclosed species of an insecticidal agent in Paper No. 3 (1/21/03) is acknowledged. The traversal is on the ground(s) that applicant believes that a search of the entire application can be made without undue burden. This is not found persuasive because applicant's remarks are not relevant to an election of species requirement, wherein only distinctness between the species is required because all species would eventually be examined if all species are allowable. Hence, undue burden need not be shown for an election of species requirement.

The requirement is still deemed proper and is therefore made FINAL.

Applicant is advised of the following. Subject matter that specifically requires and encompasses gossypol + fungi insecticide + feeding stimulant or food material, as claimed, is deemed to be allowable. Before a notice of allowance is issued, when and if appropriate, a search update would have to be done regarding the above noted allowable subject matter.

Present examination shall now continue with the following next species: gossypol + any type of insecticide, the insecticide being optionally present (i.e. scope of claims 12-19 without additional insecticide is covered herein).

Claim 21 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 21, azadirachtin, hydramethylnon and imidacloprid are recited twice.

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It is noted that "caryophylene" is a misspelling in line 3 of claim 23. Two l's are needed. Also in claim 23, "mixtures of the foregoing" is unclear language. Amendment to "mixtures thereof" would be acceptable.

Applicant is advised that in claims 1 and 25, the phrase "such that" would be improved by amending it to "so that." The term such can have exemplary or limiting scope, and therefore, the suggested "so that" is preferred.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 12-15 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Chemical Abstracts 102:201189.

Chemical Abstracts 102:201189 explicitly discloses bark and wood of *Montezuma speciosissima*. It is disclosed that the bark and wood yielded 0.02% gossypol. 0.02% is about 200 ppm. While the feature of the gossypol is not stated in verbatim language as in the instant claim (e.g. concentration of gossypol is not biocidal without insecticide, but sufficient to significantly increase the efficacy of the insecticide), it is the Examiner's position that 200 ppm is

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clearly within such concentration amount range, as evidenced by applicant's claims 3-5. The claims are thereby anticipated.

Claims 1-16 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by WPIDS abstract 1992-406126 (abstracting SU 1703030).

WPIDS abstract 1992-406126 explicitly discloses a vegetable material from ground cotton seed that contains 6.5-10.5% moisture and volatile substances, 2.8% fat, 48.7% protein, 6/8% cellulose, 0.01% free gossypol (about 100 ppm), 0.07% bound gossypol and up to 0.63 mg/kg of chloroorganic pesticide. This material contains every component that is required in applicant's claims. While the feature of the gossypol is not stated in verbatim language as in the instant claim (e.g. concentration of gossypol is not biocidal without insecticide, but sufficient to significantly increase the efficacy of the insecticide), it is the Examiner's position that 100 ppm is clearly within such concentration amount range, as evidenced by applicant's claims 3-5 and 13-15. The claims are thereby anticipated.

Claims 17-19 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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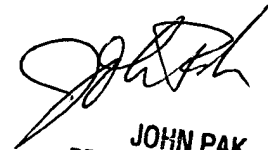
Claims 25-27 are deemed allowable at this time. Applicant is advised to amend claim 25 to substitute "so that" for "such that," as discussed above. A search update would have to be carried out before the issuance of Notice of Allowance, if and when appropriate.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Friday from 7:30 AM to 4 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


JOHN PAK
PRIMARY EXAMINER
GROUP 1600